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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,584	02/05/2002	Laszlo Marton	16139/09017	8264

7590 12/31/2002

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EXAMINER

HAAS, WENDY C

ART UNIT	PAPER NUMBER
1661	

DATE MAILED: 12/31/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/068,584	MARTON ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Wendy C Haas	1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 05 February 2002.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-31 are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a)  The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## ELECTION/RESTRICTION

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-17, 21, drawn to a method of plant tissue culture, classified in class 435, subclass 410.
- II. Claims 18-20, 22, 23, drawn to a method for producing a transgenic plant, classified in class 800, subclass 278.
- III. Claims 24, 26, drawn to a plant or plant part, classified in class 800, subclass 298.
- IV. Claims 25, 27, drawn to a transgenic plant or transgenic plant part, classified in class 800, subclass 298.
- V. Claims 28 and 29, drawn to a method of purifying a liquid, classified in class 210, subclass 602.
- VI. Claims 30 and 31, drawn to a method of hazardous waste disposal, classified in class 588, subclass 205 .

The inventions are distinct, each from the other because of the following reasons:

Groups III and IV and each of groups V and VI are related as a product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used in several materially different processes, for example, the plant could be used ornamentals or as raw material for the production of ethanol instead of as a waste remediation tool.

Group III and IV and each of Groups I and II are related as a product and process of making. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product could be made by any one of several other methods of producing a tissue cultured or transgenic plant that are known in the art , e.g. particle bombardment, or simply growing a normal plant.

Group III differs from Group IV as the plants of Group III are not genetically modified while the plants of Group IV are genetically altered. As this critical embodiment of each of these inventions clearly differs, a separate search would be required for each group even though Groups III and IV are classified together.

Group I differs from Group II, as methods of genetic transformation are clearly different from methods of in vitro tissue culture, as evidenced by their placement in different classes and because a separate search would be required for each. Furthermore, there is nothing on the record to suggest that the two inventions are obvious variants.

Each of Groups I, II, V and VI have acquired a separate status in the art, as evidenced by their placement in different classes. The methods of Groups I and II are not required to practice the methods of Groups V and VI, and vice versa. A separate search would be required for each group.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

If any group other than Group V or VI is elected, applicant is required under 35 U.S.C. 121 to provide an election of species to a single disclosed plant species (such as those listed in claim 6) for prosecution on the merits to which the claims shall be restricted .

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

**FUTURE CORRESPONDENCE**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wendy C. Haas whose telephone number is (703) 308-8898. The Examiner is generally available Monday through Friday from 9 a.m. to 5 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax number for the group is (703) 305-3041 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 308-0196.

W. C. Haas



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TECHNOLOGY CENTER 1600